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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/024,621  
Filing Date: December 21, 2001  
Appellant(s): GIACCHETTI ET AL.

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Kenie Ho  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 8/01/2005 appealing from the Office action mailed 12/01/2004.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

WO 01/18674 A2	MALONEY et al.	3-2001
US 2003/0078854 A1	SHIM	4-2003
US 3,936,957	NORDBYE	2-1976
US 3,968,661	WILLIAMS	7-1996

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-69 are unpatentable under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The Claims recite *providing beauty advice being a function of an astrological horoscope sign of the subject*. However, the relationship between *astrological horoscope sign* and *a beauty product* is not clear. The specification does not provide any indication of how *an astrological horoscope sign* and *a beauty product* are interrelated. Furthermore, the examiner points out that knowledge in *astrology and cosmetic industry* is of such a different nature that it is not possible to envision how one would arrive to choosing a beauty product for a person based on knowing a horoscope sign of the person. Therefore, the functionality connecting the method steps of: "receiving astrological horoscope sign of a consumer" and "recommending to the consumer a beauty product", which is critical or essential to the practice of the invention, is not included in the Claims and is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPO 356 (CCPA 1976).

### ***Claim Rejections - 35 USC § 101***

Upon reconsideration, Claim Rejections under 35 USC § 101 have been withdrawn.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1, 4-6, 9-15,17-20, 24-27, 29-36,43-47, 51-53, 56, 59-62 and 64-67 are unpatentable under 35 U.S.C. 102(e) as being anticipated by Maloney et al. (WO 01118674 A2).**

Maloney et al. (hereinafter Maloney) teaches a method and system for providing a customized product combination to a consumer, comprising:

#### ***Independent Claims***

Claims 1, 53, 59 and 67.

Receiving profile information about a consumer, the profile information reflecting at least one of physical attribute information and lifestyle information (page 6, line 29 - page 7, line 2);

receiving information reflecting a classification (categories and sub-categories) relating to birth of the consumer (page 7, lines 2-12);

providing guidance to the consumer including at least a beauty advice (customized product), the guidance being a function of at least some of the profile information and birth-related classification (life stage) information of the consumer (page 7, lines 2-11, 30-31).

Claim 36.

Establishing a set of criteria/categories and a decision tree algorithm for classifying a consumer, the criteria including at least one of personal attribute information and lifestyle information (page 7, lines 1-15);

advising the subject of the at least one predefined categories into which the subject is classified (page 7, lines 13-19); and

dispensing guidance including beauty advice (customized product), the guidance being a function of an lifestyle and birth-related classification (life stage) information of the consumer and the at least one predefined category (sub-category) into which the subject is classified (page 7, lines 2-11, 30-31).

Claim 56.

Providing a web server and a plurality of web pages relating beauty products (page 16, lines 19-28);

establishing a relationship between the first website and a second website (client/server model) (page 16, lines 19-28), said establishing including dispensing birth-related classification (life stage) information (page 7, lines 2-11);

providing to a user of the second website a recommendation to use a beauty product offered for sale through the first website, the recommendation being a function of a birth-related classification (life stage) information of the customer (page 7, lines 2-11; column 17, lines 21-29; page 22, lines 9-10);

providing on the second website a link to the first website, and informing the user of the second website of the ability to purchase the beauty product through the link to the first website (embedding URLs within said web pages to provide the hypertext links to other pages) (page 16, line 20 - column 17, line 5; page 22, lines 9-16).

Dependent Claims

Claim 4. See reasoning applied to Claim 1.

Claims 5-6. See reasoning applied to Claim 1.

Claims 9-10. Prompting the consumer to provide profile information, the prompting including posing to the subject a plurality of questions seeking physical attribute information about at least one of the subject's hair, skin, eyes, and facial features (page 9, lines 4-6, 17).

Claims 11-15. See reasoning applied to Claim 1.

Claim 17. See reasoning applied to Claim 1.

Claim 18. Said method and system wherein a beauty product is selected by the consumer (page 7, line 19). Selection of the beauty product inherently indicates selection of a brand name of said beauty product.

Claims 19-20. See reasoning applied to Claim 1.

Claim 24. Said method and system, including providing a beauty advice (page 7, lines 30-31). Information as to the specific content of said advice is not given patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed. The method steps, disclosed in Maloney would be performed the same regardless of the specific content of said beauty advice.

Claim 25. See reasoning applied to Claim 1.

Claim 26. Maloney teaches said method, wherein the address is an e-mail address (page 6, line 32).

Claim 27. Said method, wherein the information about how to purchase the beauty product includes a hyperlink to a location from which the beauty product may be ordered (page 16, lines 26-34).

Claim 29. Storing an identification code of the subject (page 17, lines 12-13).

Claim 30. Maloney teaches said method, wherein the guidance is

based on at least one of a demographic location of the subject and an environmental condition at a demographic location of the subject (page 17, line 33).

Claim 31. See reasoning applied to Claim 1.

Claim 32. See reasoning applied to Claim 1.

Claim 33. See reasoning applied to Claim 27.

Claims 34-35. See reasoning applied to Claim 1.

Claims 43-45. See reasoning applied to Claim 36.

Claim 46. Said method and system, wherein personal attribute information characterizes at least one of the subject's hair, skin, eyes, and facial features (page 7, line 1).

Claim 47. See reasoning applied to Claim 36.

Claim 51-52. See reasoning applied to Claim 36.

Claim 60-62 and 64-66. See reasoning applied to Claim 59.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 2-3, 7-8, 16, 28, 37-42, 54-55, 57-58, 63 and 68-69 are unpatentable under 35 U.S.C. 103(a) over Maloney et al. in view of Shim (US 2003/10078854).**

### **Independent Claims.**

Claim 55. Maloney teaches said method, comprising: receiving profile information about the consumer, the profile information reflecting at least one of physical attribute information and lifestyle information about the consumer; recommending at least one beauty product to the consumer as a function of the received profile information (page 6, line 29 - page 7, line 15).

However, Maloney does not teach that said received information includes information reflective of an astrological horoscope sign of the subject; and that said recommending a beauty product step is conducted as a function of the consumer astrological horoscope sign.

Shim teaches a method and system for providing advertisement over a network, wherein consumers are classified in accordance with information including a zodiac sign, consumer's birthday and year the consumer was born [0174]; [0180]; [0194]. Said information and classification is utilized to offer the consumers beauty-related advertisement, products and services [0052]; [0068]; [0207].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Maloney to include recommending a beauty product to the consumer as a function of the collected from the consumer information including a zodiac sign, consumer's birthday, the year the consumer was born and consumer astrological horoscope sign, as disclosed in Shim, because it would advantageously attract attention to said advertising campaign, thereby increase the effectiveness of advertising and bring more revenue. Furthermore, said collected consumer information including a zodiac sign would allow classify consumers into various types, including "restrain type", "stability type" and "sentiment type", which in turn allow to provide a targeted beauty-related advertisement to each type of consumers (Shim, [0195]; [0200]; [0201]).

#### Dependent Claims

Claims 2-3,7-8,16 and 54. See reasoning applied to Claim 55.

Claim 28. Shim teaches said method, wherein the address is an address of a mobile receiver/transmitter of the customer [0026]. The motivation to combine Maloney and Shim would be to advantageously allow customer to obtain beauty-related information at any convenient for the customer time and place.

Claims 37-38. See reasoning applied to Claim 55.

Claim 39. See reasoning applied to Claim 55.

Claims 40-42. See reasoning applied to Claim 55.

Claims 57-58. See reasoning applied to Claim 55.

Claims 63 and 68-69. See reasoning applied to Claim 55.

**Claims 21-23 and 48-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maloney et al. in view of Shim, further in view of Nordbye (US 3,936,957) and further in view of Williams (US 3,968,661).**

**Dependent Claims**

Claims 21-23 and 48-50. Maloney teaches all the limitations of Claims 21-23 and 48-50, including receiving from the consumer personal beauty information including birth-related information; and recommending a beauty product based on said information (page 7, lines 1-2), except specifically teaching making a suggestion that a course of future events may change based on use of at least one specified beauty product.

Shim teaches said method for providing advertisement of beauty-related products over a network, wherein consumers are classified in accordance with personal information including a western zodiac sign fortune, consumer's birthday and year the consumer was born [0194]. Said information and classification is utilized to determine the social type of the consumer [0174]; [0180]; and offer to the consumer beauty-related advertisement, products and services [0052]; [0068]; [0207].

Determining the social type of the consumer indicates predicting (suggesting) future behavior of the consumers. However, Shim does not explicitly teach that said zodiac signs of fortune are associated with changing a course of future events.

Nordbye teaches that throughout history it has been customary for people to wear various adornments for superstitious purposes. For example, jewelry with zodiac signs were worn to bring good luck (C. 1, L. 5-9, 30), thereby indicating that the course of future events may be changed based on use of a certain jewelry incorporating said zodiac signs of fortune. However, Nordbye does not explicitly teach that jewelry relates to cosmetic purposes.

Williams teaches an article of jewelry for personal wear comprising zodiac signs provided thereon; wherein said article has a cosmetic significance (C. 2, L. 5, 30; C. 3, L. 22).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Maloney to include recommending a beauty product to the consumer as a function of the collected from the consumer information including a zodiac sign, consumer's birthday, the year the consumer was born and consumer astrological horoscope sign, as disclosed in Shim, because it would advantageously attract attention to said advertising campaign, thereby increase the effectiveness of advertising and bring more revenue. Furthermore, said collected consumer information including a zodiac sign would allow classify consumers into various types, including "restrain type", "stability type" and "sentiment type", which in turn allow to provide a targeted beauty-related advertisement to each type of consumers (Shim, [0195]; [0200]; [0201]).

And it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Maloney and Shim to include that the use of said beauty product recommended based on consumer's zodiac sign of fortune could result in a predicted future occurrence, as disclosed in Nordbye and Williams, because it would advantageously stimulate the consumers to buy said beauty product, thereby increase revenue.

#### **(9) Response to Arguments**

##### ***Claim Rejections - 35 USC § 112***

In response to applicant's argument that the examiner did not provide any evidence why the connection between *astrological horoscope sign* and a *beauty product* is not clear, the examiner maintains that knowledge in *astrology and cosmetic industry* belong to different fields of expertise, and is of such a different nature that it is not possible to envision how one would arrive to choosing, for example, a most suitable skin-care product for a person based on knowing a horoscope sign of the person. Furthermore, it is not clear how the knowledge that a person is born in the "Year of the Mouse" can contribute to the decision what type of supplements, including

biobotanicals, organic products and vitamins should be recommended to the customized cosmetic product. Moreover, it is not clear how the knowledge that a person is classified by a particular star sign can guide a process of formulation a cosmetic product best suitable for the consumer's physiological condition including skin dryness or oiliness. Therefore, the examiner maintains that the specification does not provide any indication of functionality connecting the method steps of: "receiving astrological horoscope sign of a consumer" and "recommending to the consumer a beauty product", which is critical or essential to the practice of the invention.

#### ***Claim Rejections - 35 USC § 101***

Claim Rejections under 35 USC § 101 have been withdrawn, therefore the argument is moot.

#### ***Claim Rejections - 35 USC § 102***

In response to applicant's argument that Maloney fails to disclose *providing guidance for the subject, the guidance at least including beauty advice and being a function of at least some of the profile information and birth-related classification*, the examiner points out that Maloney explicitly teaches said features. Specifically, Maloney teaches:

*providing guidance for the subject, the guidance at least including beauty advice* (the consumer is provided a customized product based on the collected consumer profiling data) page 7, lines 30-31;

*said beauty advice being a function of at least some of the profile information* (collecting consumer profiling data, page 6, line 30), *and birth-related classification* (consumer profiling data is matched against a decision tree to be assigned to various profile sub-categories, said profile information including consumer life stage information, page 7, lines 2-12).

The Claims recite the term *birth-related*. Maloney discloses this feature: *life stage* (page 7, line 2).

Same reasoning applied to the applicant's argument that Maloney does not disclose *recommending at least one beauty product to the subject as a function of the birth-related classification of the subject and at least some of the received profile information*.

### ***Claim Rejections - 35 USC § 103***

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both Maloney and Shim relate to providing consumers with beauty-related products and services based on collected consumer information. The motivation to combine Maloney and Shim to include recommending to the consumer said beauty product as a function of a zodiac sign and consumer's birthday and consumer astrological horoscope sign would be to advantageously enhance the effectiveness of advertising of said beauty-related products, thereby potentially increase revenue (Shim, [0195]; [0200]; [0201]).

In response to applicant's argument that Shim fails to disclose *providing guidance for the subject, the guidance at least including beauty advice and being a function of at least some of the profile information and birth-related classification*, the examiner points out that Maloney was applied for this feature (See a discussion above).

Same reasoning applied to the applicant's argument that Shim does not disclose *recommending at least one beauty product to the subject as a function of the birth-related classification of the subject and at least some of the received profile information.*

In response to applicant's argument that neither Shim nor Maloney teaches separately or in combination *providing guidance for the subject, the guidance at least including beauty advice related to at least one beauty product and being a function of the subject's astrological horoscope sign and at least some of the received profile information*, the examiner points out that Maloney discloses:

*providing guidance for the subject, the guidance at least including beauty advice (the consumer is provided a customized product based on the collected consumer profiling data) page 7, lines 30-31;*

*said beauty advice being a function of birth-related information (life stage, page 7, lines 2-12), and at least some of the profile information (collecting consumer profiling data, page 6, line 30).*

Shim was applied to show *providing consumers with beauty-related advertisement, products and services [0068]; [0207] based on collected from the consumers profiling information including a zodiac sign and year the consumer was born [0174]; [0180]; [0194].*

In response to applicant's argument that neither Nordbye nor Williams separately or in combination teach *providing guidance for the subject, the guidance at least including beauty advice and being a function of at least some of the profile information and birth-related classification, or dispensing guidance including beauty advice, the guidance being a function of birth-related classification of the subject and at least one predefined category into which the subject is classified*, the examiner points out that Maloney was applied for this feature. Specifically, Maloney teaches:

*providing guidance for the subject, the guidance at least including beauty advice (the consumer is provided a customized product based on the collected consumer profiling data) page 7, lines 30-31;*

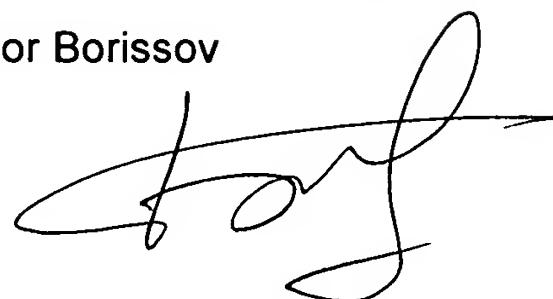
*said beauty advice being a function of at least some of the profile information (collecting consumer profiling data, page 6, line 30), and birth-related classification (consumer profiling data is matched against a decision tree to be assigned to various profile sub-categories, said profile information including consumer life stage information, page 7, lines 2-12).*

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine Maloney and Shim would be to advantageously enhance the effectiveness of advertising of said beauty-related products, thereby potentially increase revenue (Shim, [0195]; [0200]; [0201]). The motivation to combine Maloney and Shim to include that the use of said beauty product recommended based on consumer's zodiac sign of fortune could result in a predicted future occurrence, as disclosed in Nordbye and Williams would be to advantageously stimulate the consumers to buy said beauty product, thereby increase revenue.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Igor Borissov



IB

10/17/2005

Conferees:

John Weiss *John 10-17-05*  
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